

REMARKS

After entry of the amendment, claims 1-8, and 22-29 are pending. No issues of new matter should arise, and entry of the amendment is respectfully requested. Support for claims 25-27 is found at least on page 28 of the present application, and on page 3 of provisional application Serial No. 60/128,473, to which this application claims priority. Support for claim 28 is found at least on pages 26-31 of the specification. Support for claim 29 is found at least on page 10, lines 9-12 of the specification. Reconsideration of the claims, as amended, is also respectfully requested.

On page 3 of the Office Action, the Examiner has taken the position that “[t]he specification of the Provisional Application does not provide literal support for the steps of elected claims 1-8 of the instant application.” Applicants submit that the referenced Provisional Application does provide support for the presently pending claims, particularly as amended. However, with respect to the present Office Action, the Examiner’s position is moot insofar as the Examiner has not asserted a reference that is dated between the Provisional Application and non-Provisional (this) Application filing dates.

Applicants also note that on page 3 of the Office Action, the Examiner appears to be comparing the claims of the Provisional Application to the (originally filed) claims of the present application. Applicants note that the issue is not how closely the respective claims of the two applications correspond with each other, but rather whether the Provisional Application as a whole provides support for the presently claimed invention. Applicants are, of course, entitled to the Provisional Application priority date for at least the subject matter that is claimed in the present application and disclosed in the Provisional Application.

The 35 U.S.C. §112, First Paragraph, Lack of Written Description Rejections

On page 4 of the Office Action, the Examiner rejected claims 1-8 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention. Applicants traverse the rejection.

On page 4 of the Office Action, the Examiner takes the position that support is not found in the specification for the “at least one” chemical description limitation. Applicants traverse the Examiner’s assertion insofar as the claims are part of the specification and thus, by themselves, constitute written description of the invention.

As stated in *In re Gardner*, 178 USPQ 149, 149 (C.C.P.A. 1973), “we consider the original claim in itself adequate ‘written description’ of the claimed invention. It was equally a ‘written description’ whether located among the original claims or in the descriptive part of the specification.” Further, as stated in *In re Wertheim*, 191 USPQ 90, 96 (C.C.P.A. 1976), “[i]t is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.” The Examiner is requested to withdraw this rejection.

The term “coordinate system” has been deleted from the claims. Accordingly, the Examiner’s rejections with regard to the phrase “coordinate system” on pages 5 and 6 of the Office Action are rendered moot.

On pages 5-6 of the Office Action, the Examiner states that “page 27 discloses generation of multiple column vectors for each compound.” The Examiner is incorrect. Page 27 states that “the column vectors of *X* describe each molecule.” Page 31 of the specification states that “the value of matrix element (*i*, *j*) of *X* is the frequency of descriptor *i* in molecule *j*.” The specification thus provides support for the claimed invention. However, and in any event, in view of the *Gardner* and *Wertheim* cases cited above, the Examiner’s rejection is inapposite insofar as the claims themselves also constitute written description. The Examiner is requested to withdraw this rejection.

With regard to claim 2, the phrase “chemical connection tables” has been deleted from the claim. The Examiner’s rejection is thus rendered moot.

The Examiner has rejected claim 8 because the specification “recites the phrase ‘identity matrix I’ on page 9, but does not otherwise identify or describe such a matrix.” In view of the *Gardner* and *Wertheim* cases cited above, Applicants submit the Examiner’s statement is inapposite. Accordingly, the Examiner is requested to withdraw this rejection.

The 35 U.S.C. §112, First Paragraph, Lack of Enablement Rejections

On pages 7-8 of the Office Action, the Examiner has rejected the claims based on the phrase “coordinate system.” However, as noted above, the phrase “coordinate system” has been deleted from the claims. Accordingly, the Examiner’s rejection of the claims with respect to the phrase “coordinate system” is rendered moot.

The 35 U.S.C. 112, Second Paragraph, Rejections

The claims have been amended to render moot the Examiner’s rejection of claims 1-8 under 35 U.S.C. §112, second paragraph.

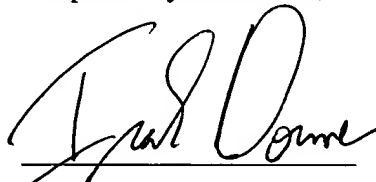
In view of the foregoing, Applicants respectfully request that the presently pending claims be passed to issue. If there are any matters that would delay this Application from passing to issue, the Examiner is requested, at his earliest convenience, to telephone the undersigned to resolve such matter(s).

AUTHORIZATION

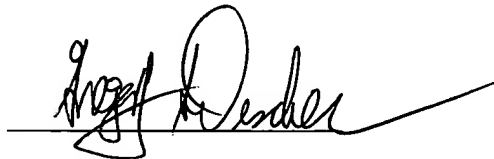
The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully submitted,



Irah H. Donner
Registration No. 35,120



Gregory S. Discher
Registration No. 42,488

Date: 12/02/03

HALE AND DORR LLP
1455 Pennsylvania Ave, N.W.
Washington, D.C.
(202) 942-8437 (telephone)
(202) 942-8484 (facsimile)